

Remarks

Reconsideration is requested.

The allowance of claims 19-20 is acknowledged. New claim 21 has been added which is allowable for the same reasons that make claims 19-20 allowable. Claim 1, as amended, is also believed to be allowable for the same reasons that make claims 19-20 allowable. As claims 3-9 depend on claim 1, they too are allowable. Claim 10, as amended, is also believed to be allowable for the same reasons that make claims 19-20 allowable. As claims 12-18 depend on claim 10, they too are allowable.

The Examiner has objected to claims 13-16 as having antecedent problems. Claims 14-16 have been amended to obviate the objection. No problem was found with claim 13. It is assumed that the Examiner only intended to object to claims 14-16.

New claim 21 includes various limitations from previous claims 1, 3, 5 and 8. In rejecting claims 1 and 3, the Examiner combined the Clark et al. reference with the Wang reference. In rejecting claim 5, the Examiner combined the Clark et al. reference, the Wang reference, and Motamed. In rejecting claim 8, the Examiner combined the Clark et al. reference with the Wang reference, and the Selby reference. Applicant's attorney assumes that the Examiner may be tempted to combine Clark et al., Wang, Motamed, and Selby to reject new claim 21.

However, it is believed that insufficient evidence is available to support such a combination. The Federal Circuit discussed proper motivation in the case of *In re Lee*, 61 USPQ 2d 1430 (Fed. Cir. 2002). The motivation identified in the Office Action is akin to the conclusory statements set forth in *In re Lee* which were found to fail to provide the requisite motivation to support an obviousness rejection. The Court in *In re Lee* stated the factual inquiry whether to combine references must be thorough and searching. It must be based on objective evidence of record. The Examiner's conclusory statements in the *Lee* case did not adequately address the issue of motivation to combine. The Court additionally stated that the factual question of motivation is material to

patentability and cannot be resolved on subjective belief and unknown authority. The Court also stated that deficiencies of cited references cannot be remedied by general conclusions about what is basic knowledge or common sense. The Court further stated that the determination of patentability must be based on evidence.

In the instant case, the record is devoid of evidence to support motivation to combine the teachings apart from the conclusory statements which are insufficient for proper motivation. There is no evidence that the device of Clark et al. is deficient with respect to calibration such that one would be motivated to look for other solutions or that any improvement would result from the combination of the reference teachings. The only rationale is the subjective opinion of the Examiner improperly based upon Applicant's own disclosure. There is no motivation to combine the reference teachings and the Office has failed to establish a *prima facie* rejection for at least this reason.


It would not be obvious to combine Clark et al., Wang, Motamed, and Selby because there is no teaching in the references which would suggest their combination. It would not be obvious to substitute a portion of the structure of one of these references for a portion of the structure of another reference because there is no teaching in the references themselves of how the components should be combined or of which components of Selby, Motamed, or Wang should be combined with which components of Clark et al. There are no teachings in the references themselves which teach that there would be any advantage resulting from selecting portions of the structure of Selby, Motamed, or Wang and integrating that structure somehow into the structure of Clark et al. The mere fact that the structures of the references could possibly be somehow modified to result in the claimed structure does not render the claimed structure obvious unless the references themselves suggest the desirability of the modification.

Therefore, claim 21 is allowable.

In view of the foregoing, allowance of claims 1, 3-10, and 12-21 is requested.

The Examiner is requested to telephone the undersigned in the event that the next Office Action is one other than a Notice of Allowance. The undersigned is available for telephone consultation at any time.

Respectfully submitted,

Dated: Aug. 16, 2006 By: 
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